APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,429	12/23/1999	DONALD E. WALLAR II	ST9-99-070	7384

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EXAMINER
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ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/471,429	WALLAR II, DONALD E.
	Examiner	Art Unit
	Sanjiv D. Shah	2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>31 October 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 10-29* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7, 10-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   This action is responsive to communications: Request for Reconsideration filed

on 10/31/2005.

2.   Claims 8 and 9 are cancelled. Claims 1-7 and 10-29 are pending in the case.

Drawings

3.   The drawings filed on 12/23/99 are objected to as indicated in the attached

PTO-948 form. Formal corrected drawings can be filed at allowance.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless (a) the invention was known or used by

others in this country, or patented or described in a printed publication in this or a

foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section

122(b), by another filed in the United States before the invention by the applicant for

patent or (2) a patent granted on an application for patent by another filed in the United

States before the invention by the applicant for patent, except that an international

application filed under the treat) defined in section 351 (a) shall have the effects for

purposes of this subsection of an application filed in the United States only if the

international application designated the United States and was published under Article

21(2) of such treaty in the English language.

5.   Claims 1, 10, 15, and 20-29 are rejected under 35 U.S.C. 102(e) as being

anticipated by Guck (USPN 5,911,776 -filed on 12/1996, herein after "~Guck").

Regarding independent claims 1,10, 15, 20, 21, and 23, Guck discloses:

Composing a computer message (on col. 2, lines 1-19 teaches an author could

originate a text or message of his own personal format), comprising the steps of: (a)

presenting a message composition area for entry of an unformatted message into one

text field(on col. 2, lines 1-19, col. 6, lines 10-28, and col. 12, lines 56-65 teaches an

author can create its own message or document in his own format such as Rich Text

Format (RTF) (unformatted); the RTF is not a tagging language like TIFF, SGML or

HTML) and at least one selection field associated with text field (See Guck, col. 16,

lines 40-45, Specifically line 44, wherein Guck teaches selection field to select

converter). message format selector for selecting an output format from a plurality of

formats (col. 16, lines 15-25 and on co1.6, lines 49-64 teaches the user sender can

change the document by reformatting it in any one of the formats required for the

intended recipients); a formatted message display area; converting unformatted

message to form a formatted message with format tags of said on of output formats (on

col. 5, lines 29-33, col. 6, lines 49-64, and on col. 9, lines 57-65 teaches converting Rich

Text format (an untagged format) into TIFF (a tagged format); wherein the document will

be formatted in TIFF for display). Presenting message into one text field (col. 12, lines

57-60, wherein the file is a word file. It is inherent that a text field is present) having at

least one associated selection field (col. 16, lines 13-23, wherein author creates text file

and defines MIME type and selects format. It is inherent that file type is selected (MIME) along with format) and formatted message structured according to output format and selection field (Col 16, lines 15-23, as discussed above. It is inherent that output formatted message is structured in context with selection)

Regarding dependent claims 22 and 24, Guck discloses: displaying said formatted message for user review (on col. 7, lines 6-10: teaches text of a document or message can be displayed for review).

Regarding claims 25-29, they are substantially similar to claims 20-24 and are rejected under same rational.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 2-7, 11-14, and 16-19 arc rejected under 35 U.S.C. 103(a) as being

unpatentable over Guck, as applied to claims 1, 10, 15, and 20-29 above, in view of

Ferrel et al. (USPN 6,230,173 B1 -fled on 07/19'95).

Regarding dependent claims 2, 11, and 16, Guck discloses. the invention substantially

as claimed as described supra. However, Guck does not explicitly disclose "message

formats include SGML and book manager script".

Ferrel on col. 20, line 57 - col. 21, line 26 and col. 2.3, lines 30-33 teaches converting

Rich Text (RTF) into a Multimedia Data Format file (MDF); wherein the MDF is the

MPML markup language tagged storage; wherein MPML text derived from SGML and

HTML.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Ferrel into Guck to provide a way to author

documents from Rich Text format (RTF) to be converted into a MDF being a MPML

markup language tagged storage, as taught by Ferrel, incorporated into the converting

of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded

objects within the structure of the document in an authoring environment.

Regarding dependent claims 3, 12, and 17, Guck discloses:

a formatted message display area (Duck on col . 5, lines 29-33, col. 6, lines 49-64, and

on col. 9, lines 57-65 teaches converting Rich Text format (an untagged format) into

TIFF (a tagged format); wherein the document will be formatted in TIFF for display).

Regarding dependent claims 4,13, and 18, Ferrel discloses:

wherein computer instructions for steps (a) and (b) are implemented in Java script

(Ferrel on col. 14, line 65 -col. 15, line 3 teaches scripting controls to respond to actions

or automatically perform actions at runtime).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Fen-el into Guck to provide a way to author

documents from Rich Text format (RTF) to be converted into a MDF being a MPML

markup language tagged storage, as taught by Ferrel, incorporated into the converting

of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded

objects within the structure of the document in an authoring environment.

Regarding dependent claims 5, 14, and 19, Guck discloses "wherein said unformatted

message is a first unformatted message, said formatted message is a first formatted

message, said message area further includes a formatted display area" on col. 5, lines

29-32 teaches converting rich text format (RTF) into the TIFF format (tag format).

Ferrel discloses "in response to entry of a second unformatted message into said

second message composition area, converting said unformatted message to form a

formatted message with format tags of said one of said output formats; and (d)

presenting said first and second formatted messages as a concatenated complete

message for display in said formatted message display area", on col. 2, lines 36-47

teaches creating an displaying stories that are formatted from text document into SGML

or HTML to be displayed in an on-line network; wherein producing documents that are tagged in either the SGML and HTML format (first and second message composition area); col. 3, lines 46-65 and on col. 20, line 57 --col. 21, line 26 teaches converting Rich Text format (RTF) to a MDF that holds is tagged language MPML (converting unformatted message into format tags).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified Ferrel into Guck to provide a way to author documents from Rich Text format (RTF) to be converted into a MDF being a MPML markup language tagged storage, as taught by Ferret, incorporated into the converting of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded objects within the structure of the document in an authoring environment.

Regarding dependent claim 6, Guck discloses:

Guck discloses "editing first and second formatted messages and sending a copy of the formatted message to a computer message file" on cot. 6, lines 49-64 teaches author or user sender selects among various formats to reformat his document to send to various recipients and on cot. 12, lines 56-65 teaches creating a file and defining the file in a alternate format. Regarding dependent claim 7, Ferrel discloses:

wherein said first and second composition areas and said formatted message display area are formed in a template that is presented an a web page, and wherein steps (e) and (f) are performed via said web page (Ferret on cot. 3, lines 46-65 teaches using Word template to help author produce documents with valid embedded codes).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have modified Ferrel into Guck to provide a way to author

documents from Rich Text format (RTF) to be converted into a MDF being a MPML

markup language tagged storage, as taught by Ferrel, incorporated into the converting

of RTF into TIFF, as taught by Guck, in order to provide the ability to place embedded

objects within the structure of the document in an authoring environment.

Response to Arguments

8.   Applicant's arguments filed 10/31/05 have been fully considered but they are not

persuasive.

Applicant argues that Guck fails to teach entering data by user in associated selection

field. Examiner disagrees. Specifically as recited in body of rejection Guck teaches

selecting a converter as described in col. 16, lines 40-45, that is equivalent to claimed

selection field. Applicant further argues that amended claims presents limitation of user

entering format and how data is structured in its presentation of format. Examiner

disagrees. Specifically the argued limitation is not claimed. The claimed invention

presents a selection field along with text field and is silent about user entering structured

data. Also Guck teaches definition phase as described in fig 3, wherein user enters

format and file type (MIME), which is equivalent to claimed structured entry. Therefore

applicant's arguments are not persuasive.

1.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Sanjiv D. Shah whose telephone number is (571) 272-

4098. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone

number for the organization where this application or proceeding is assigned is 571-

273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Sanjiv D. Shah
Primary Examiner
Art Unit 2627

S. Shah
January 5, 2006